



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,543	01/17/2002	David E. Lam		7769

28213 7590 04/22/2003

GARY CARY WARE & FRIENDENRICH LLP  
4365 EXECUTIVE DRIVE  
SUITE 1100  
SAN DIEGO, CA 92121-2133

EXAMINER

RAO, MANJUNATH N

ART UNIT	PAPER NUMBER
----------	--------------

1652

DATE MAILED: 04/22/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/914,543

Applicant(s)

LAM ET AL.

Examiner

Manjunath N. Rao, Ph.D.

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 October 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-16 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \*   c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

Art Unit: 1652

## DETAILED ACTION

### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-9, 13-16 drawn to a polypeptide with SEQ ID NO:2, polynucleotide with SEQ ID NO:1, vectors and host cells comprising said polynucleotides.

Group II, claim(s) 1-9, 14-16 drawn to a polypeptide with SEQ ID NO:4, polynucleotide with SEQ ID NO:3, vectors and host cells comprising said polynucleotides.

Group III, claim(s) 1-9, 14-16 drawn to a polypeptide with SEQ ID NO:6, polynucleotide with SEQ ID NO:5, vectors and host cells comprising said polynucleotides.

Group IV, claim(s) 1-9, 14-16 drawn to a polypeptide with SEQ ID NO:8, polynucleotide with SEQ ID NO:7, vectors and host cells comprising said polynucleotides.

Group V, claim(s) 1-9, 14-16 drawn to a polypeptide with SEQ ID NO:10, polynucleotide with SEQ ID NO:9, vectors and host cells comprising said polynucleotides.

Group VI, claim(s) 1-9, 14-16 drawn to a polypeptide with SEQ ID NO:12, polynucleotide with SEQ ID NO:11, vectors and host cells comprising said polynucleotides.

Group VII, claim(s) 1-9, 14-16 drawn to a polypeptide with SEQ ID NO:14, polynucleotide with SEQ ID NO:13, vectors and host cells comprising said polynucleotides.

Group VIII, claim(s) 1-9, 14-16 drawn to a polypeptide with SEQ ID NO:16, polynucleotide with SEQ ID NO:15, vectors and host cells comprising said polynucleotides.

Group IX, claim(s) 1-9, 14-16 drawn to a polypeptide with SEQ ID NO:18, polynucleotide with SEQ ID NO:17, vectors and host cells comprising said polynucleotides.

Group X, claim(s) 1-9, 14-16 drawn to a polypeptide with SEQ ID NO:20, polynucleotide with SEQ ID NO:19, vectors and host cells comprising said polynucleotides.

Art Unit: 1652

Group XI, claim(s) 1-9, 14-16 drawn to a polypeptide with SEQ ID NO:22, polynucleotide with SEQ ID NO:21, vectors and host cells comprising said polynucleotides.

Group XII, claim(s) 1-9, 14-16 drawn to a polypeptide with SEQ ID NO:24, polynucleotide with SEQ ID NO:23, vectors and host cells comprising said polynucleotides.

Group XIII, claim(s) 1-9, 14-16 drawn to a polypeptide with SEQ ID NO:26, polynucleotide with SEQ ID NO:25, vectors and host cells comprising said polynucleotides.

Group XIV, claim(s) 1-9, 14-16 drawn to a polypeptide with SEQ ID NO:28, polynucleotide with SEQ ID NO:27, vectors and host cells comprising said polynucleotides.

Group XV, claim(s) 1-9, 14-16 drawn to a polypeptide with SEQ ID NO:30, polynucleotide with SEQ ID NO:29, vectors and host cells comprising said polynucleotides.

Group XVI, claim(s) 1-9, 14-16 drawn to a polypeptide with SEQ ID NO:32, polynucleotide with SEQ ID NO:31, vectors and host cells comprising said polynucleotides.

Group XVII, claim(s) 1-9, 14-16 drawn to a polypeptide with SEQ ID NO:34, polynucleotide with SEQ ID NO:33, vectors and host cells comprising said polynucleotides.

Group XVIII, claim(s) 1-9, 14-16 drawn to a polypeptide with SEQ ID NO:36, polynucleotide with SEQ ID NO:35, vectors and host cells comprising said polynucleotides.

---

Group XIX, claim(s) 1-9, 14-16 drawn to a polypeptide with SEQ ID NO:38, polynucleotide with SEQ ID NO:37, vectors and host cells comprising said polynucleotides.

Group XX, claim(s) 1-9, 14-16 drawn to a polypeptide with SEQ ID NO:40, polynucleotide with SEQ ID NO:39, vectors and host cells comprising said polynucleotides.

Group XXI, claim(s) 1-9, 14-16 drawn to a polypeptide with SEQ ID NO:42, polynucleotide with SEQ ID NO:41, vectors and host cells comprising said polynucleotides.

Group XXII, claim(s) 1-9, 14-16 drawn to a polypeptide with SEQ ID NO:44, polynucleotide with SEQ ID NO:43, vectors and host cells comprising said polynucleotides.

Group XXIII, claim(s) 1-9, 14-16 drawn to a polypeptide with SEQ ID NO:46, polynucleotide with SEQ ID NO:45, vectors and host cells comprising said polynucleotides.

Group XXIV, claim(s) 1-9, 14-16 drawn to a polypeptide with SEQ ID NO:48, polynucleotide with SEQ ID NO:47, vectors and host cells comprising said polynucleotides.

Group XXV, claim(s) 10-12 drawn to antibodies which bind to any of the above polypeptides.

Art Unit: 1652

The inventions listed as Groups I-XXV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Pursuant to 37 C.F.R. 1.475(d), the ISA/US considers that where multiple products and processes are claimed, the main invention shall consist of the first invention of the category first mentioned in the claims and the first recited invention of each of the other categories related thereto. Accordingly, the main invention (Group I) comprises the first recited product, polypeptide with SEQ ID NO:2 encoded by the polynucleotide with SEQ ID NO:1. Further, pursuant to 37 C.F. R. 1.475(d), the ISA/US considers that any feature which the subsequently recited products and methods share with the main invention does not constitute a special technical feature within the meaning of PCT Rule 13.2 and that each of such products and methods accordingly defines a separate invention.

---

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).


Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 1652

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 703-306-5681. The examiner can normally be reached on 7.30 a.m. to 4.00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0196.

  
MANJUNATH N. RAO  
PATENT EXAMINER

Manjunath N. Rao  
April 4, 2003.